

REMARKS

Claims 27 through 52 are pending in this Application. Applicants acknowledge, with appreciation, the Examiner's indication that claims 31, 44, and 51 contain allowable subject matter. Claims 27, 28, 31, 34, 38, 39, 41, 48, 49, and 51 have been amended. Care has been exercised to avoid the introduction of new matter. Adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, FIG. 3, ¶¶ [0005], [0006], [0009], [0036], and [0046] of the corresponding U.S. Publication No. 2002/0193102. Applicants submit that the present Amendment does not generate any new issue or new matter.

Telephonic Interview of January 7, 2010.

Applicants express appreciation for the Examiner's courtesy in granting and conducting a telephonic interview on January 7, 2010. No formal agreement was reached.

Claims 27 through 30, 32 through 43, 45 through 50, and 52 are rejected under 35 U.S.C. §102(e) as being anticipated by *McIsaac at al.* (US 2008/0195551, "*McIsaac*").

In stating the rejection, the Examiner asserted that *McIsaac* disclose all elements of the claimed inventions. Applicants respectfully traverse this rejection.

The factual determination of lack of novelty under 35 U.S.C. §102 requires the identical disclosure in a single reference of each element of a claimed invention, as those elements are set forth in the claims, such that the claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Praxair, Inc. v. ATMI, Inc.*, 543 F.3d 1308, (Fed. Cir. 2008); *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358 (Fed. Cir. 2003); *Crown*

Operations International Ltd. v. Solutia Inc., 289 F.3d 1367 (Fed. Cir. 2002); *Candt Tech Ltd. v. Resco Metal & Plastics Corp.*, 264 F.3d 1344 (Fed. Cir. 2001). Moreover, when imposing a rejection under 35 U.S.C. §102 for lack of novelty, the Examiner is required to specifically identify where in the applied reference disclosed each and every feature of the claimed invention, particularly when such is not apparent as in the present case. *In re Rijckaert*, 9 F.3d 1531 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452 (Fed. Cir. 1984). Indeed, there are fundamental differences between the claimed transaction mechanism updating scheme and *McIsaac* that scotch the factual determination that *McIsaac* disclose, or even remotely suggest, any of the claimed transaction mechanism updating schemes.

Specifically, independent claims 27, 38 and 48 recite, “causing, at least in part, actions that result in wireless reception of, by a mobile station from a management service provider, a message comprising control information for updating the mobile station **with settings of an electronic transaction mechanism** for wirelessly conducting a transaction by the mobile station directly with a merchant, wherein the merchant is independent of the management service provider; and updating **the electronic transaction mechanism** of the mobile station in response to receipt of the message, at the mobile station from the management service provider, and in accordance with the control information of the message, wherein, after updating, the mobile station is configured to conduct the transaction by the mobile station directly with the merchant **according to the updated electronic transaction mechanism** and without the management service provider.” None of these features is disclosed or suggested by *McIsaac*.

The provisional application US 60/273,595 of *McIsaac* was filed on 3/5/2001, subsequent to the effective filing date of the present application, which is 3/2/2001, the filing date of the priority document GB 0105264.6 of this application. A copy of the priority document was filed

on August 2, 2002. The original priority document is in the English language and fully supports the claimed inventions. Therefore, *McIsaac* does not constitute prior art with respect to the claimed inventions.

Moreover, the transaction mechanism updating scheme underlying the claimed inventions relates to at least a situation where the user wishes to begin using a new transaction mechanism to purchase goods or services from a new merchant or to update an existing transaction mechanism of an old merchant that has been changed (§ [0065]). A transaction mechanism is required to accomplish electronic transactions between two entities, and it can be defined to comprise features such as the communication media between the parties, predefined transaction protocols and parameters, predefined content transfer and presentation formats, security mechanisms and other functions that may also associate with an electronic transaction between the parties (§ [0005]). A dynamic template 24 contains information such as rules, references, parameters, etc. may be used in updating the transaction mechanisms in a use case of an electronic wallet (§ [0033]; [0036]).

According to the inventive transaction mechanism updating scheme, a message comprising control information for updating the mobile station for wirelessly conducting a transaction by the mobile station directly with **a merchant** is received by a mobile station from **a management service provider that is independent of the merchant**.

In contradistinction to the claimed inventions, the alleged **management service provider** in *McIsaac* specifically includes a **merchant** server 120 (page 2, last paragraph of the outstanding Office Action) that is clearly affiliated with the merchant. Therefore, the alleged management service provider in *McIsaac* **includes the merchant**, rather than “being independent of the merchant” as recited in the claimed transaction mechanism updating scheme.

In the embodiment of *McIsaac* (FIG. 4, ¶¶ [0076] through [0080]) relied upon by the Examiner, the merchant server 120 stores only orders, but not buyer private information, such that the merchant server 120 can not conduct future transactions without the security server 130 which has buyer private information. Any future transactions will involve the security server 130, rather than “conducting the transaction by the mobile station directly with the merchant and **without** the management service provider” as recited in the claimed transaction mechanism updating scheme.

It is therefore apparent that *McIsaac* operates in a manner opposite to the claimed inventions, thereby clearly teaching away from the claimed inventions. Simply put, *McIsaac* neither disclose nor suggest “updating the mobile station in response to receipt of the message, at the mobile station from **the management service provider**, and in accordance with the control information of the message, wherein, after updating, the mobile station is configured to conduct the transaction by the mobile station **directly with the merchant** and without the management service provider” as recited in the claimed transaction mechanism updating schemes. .

The above-argued fundamental and functionally significant differences between the claimed transaction mechanism updating schemes and *McIsaac* undermine the factual determination that *McIsaac* *identically* discloses the claimed transaction mechanism updating schemes within the meaning of 35 U.S.C. §102(e). *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejection of claims 27 through 30, 32 through 43, 45 through 50, and 52 under 35 U.S.C. §102(e) for lack of novelty based on *McIsaac* is not factually viable, and hence, solicit withdrawal thereof.

Based upon the foregoing, it is apparent that the imposed rejection has been overcome, and that all pending claims are in condition for allowance. Favorable consideration is therefore solicited. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at 703-822-7186 so that such issues may be resolved as expeditiously as possible.

To the extent necessary, a petition for an extension of time under 37 C.F.R. §1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 504213 and please credit any excess fees to such deposit account.

Respectfully Submitted,

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January 26, 2010
Date

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